

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 17-22 are currently pending, Claims 1-6 and 8-16 having been canceled and Claims 17-22 having been added by way of the present amendment.

New Claims 17-22 find support in original Claims 1-16, and therefore no new matter is added. It is believed that the prosecution up to this point has been hindered by lack of clarity of the claimed invention. Accordingly, Claim 17 has been drafted to specifically describe what is being claimed in a manner that should allow for straight-forward examination.

As will be discussed below, it is believed that the features contained in Claim 17 are neither taught nor suggested in combination, in the asserted prior art.

In the outstanding Office Action Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph; Claims 14-16 were rejected as being anticipated by Walker et al. (U.S. Patent No. 6,134,534); and Claims 1-6 and 8-13 were rejected as being unpatentable over Newswire article (2/3/00) in view of the www2.hertz.com reference.

In view of the cancellation of Claims 1-16, the §112, second paragraph rejection is now moot.

Claim 17 is directed to a system for renting a construction machine and includes a first network terminal, a second network terminal and a network server. The first network terminal enables a provider of a rental service to input information related to a specification, a rental situation and a location of the construction machine for rent. The second network terminal enables a person seeking the rental service to input another piece of basic information related to a specification of a construction machine of his choice, rental period and rental place along with a preferred option out of one of the specification, the rental period

and the rental place. The network server holds the information and searches for information related to a rentable construction machine on the basis of the basic information related to the specification, rental situation and location as input from the first network terminal and held by the sever. The means for searching carries out a search having searched in favor of the preferred option out of the specification, rental period and rental place.

Walker is directed to cruise ship or airline reservations and has nothing to do with renting of a construction machine. The outstanding Office Action in its rejection, explained that the Office Action gave no patentable weight for the language regarding the renting of a construction machine because this language is considered to be “non-functional” descriptive material (citing *In re Gulack*, 217 USPQ 401 (CAFC 1983)). Moreover, the outstanding Office Action explains that the type of data being stored does not render the system patentable and the renting of a construction machine is the intended use of the system.

Applicants respectfully traverse this assertion. Claim 17 has been drafted to specifically refer to the first network terminal, second terminal, and server as being able to hold information related to the specification of a construction machine for rent. The Office Action’s citation of *In re Gulack* is directed to printed matter that is not functionally related to the substrate and therefore is not relevant to the present situation. The present claims include specific information saved in memory related to the specification of a construction machine. This is not non-functional descriptive material as would be the case with printed matter (MPEP §2112.02), but rather is a structural limitation regarding how a computer memory is configured to hold information descriptive of the specification of a construction machine.

Furthermore, the outstanding Office Action asserts that Walker discloses a network server that holds server provider-type information as claimed. However, this is not what is claimed. What is claimed is information related to the specification of a construction

machine, which is specific information that has a representation of a particular type of machine. This does not relate to a provider type of information, and does not at all relate to cruise ships or airlines. Rather, this claim is specifically related to the rental of construction machines using network terminals and network servers, which is not customary in the construction machine rental industry. It is the applicants who have a pioneering invention directed to the rental of construction machines as presently claimed and is deserving of patentable weight.

Neither Walker nor the www2.hertz.com reference (directed to rental car reservations) is relevant or suggestive of the presently claimed invention. Moreover, it is respectfully submitted that when properly construed, the invention defined by Claim 17 is neither anticipated nor obvious over Walker, either taken individually or in combination with www2.Hertz.com.

Consequently, in view of the presentation of Claim 17, as well as dependent Claims 18-22, it is respectfully submitted that these claims patentably define over the asserted prior art. The present application is therefore believed to be in condition for formal allowance, and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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